



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,861	03/04/2004	Hidenori Koshikawa	0171-1069P	5251

2292 7590 10/24/2006

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,861

Applicant(s)

KOSHIKAWA ET AL.

Examiner

Katarzyna Wyrozebski

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 7,087,673 ('673). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Art Unit: 1714

Patented by Shin-Etsu Chemical '673 discloses composition comprising fluoro-rubber based on fluoropolyether in amount of 100 pbw. Composition further comprises 1-100 parts by weight of reinforcing filler such as carbon black or fumed silica. Last but not least, the composition comprises 0.1-5 pbw of peroxide crosslinking agent. The composition is further utilized to make articles such as o-rings, diaphragms, seal, coating or hose.

In the light of the above disclosure, it would be obvious to one having ordinary skill in the art that while practicing the claims of '673 one would arrive at a present invention.

3. Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,576,701 ('701). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Patented by Shin-Etsu Chemical '701 discloses composition comprising fluoro-rubber based on fluoropolyether in amount of 100 pbw. Composition further comprises 1-100 parts by weight of reinforcing filler such as carbon black or fumed silica. Silica can be treated with surface active agent. Last not least the composition comprises sufficient amount of peroxide crosslinking agent.

In the light of the above disclosure, it would be obvious to one having ordinary skill in the art that while practicing the claims of '701 one would arrive at a present invention.

4. Claims 1-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,825,267 ('267). Although the

Art Unit: 1714

conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Patented by Shin-Etsu Chemical '267 discloses composition comprising fluoro-rubber based on fluoropolyether in amount of 100 pbw. Composition further comprises 1-100 parts by weight of reinforcing filler such as carbon black or fumed silica. Silica can be treated with surface-active agent. Last not least the composition comprises 0.1-10 pbw of peroxide crosslinking agent.

In the light of the above disclosure, it would be obvious to one having ordinary skill in the art that while practicing the claims of '267 one would arrive at a present invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1714

6. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by CAPORICCIO (US 4,080,319).

CAPORICCIO discloses composition for articles such as gaskets, tubes, o-rings and foils specifically designed for operations at high temperatures.

Composition comprises fluorinated rubber that comprises repeat unit of ether having two carbons. Crosslinking agent is peroxide and reinforcing fillers include carbon black and silicas. Per 100 pbw of the rubber, carbon black has been utilized in 20 pbw and peroxide in 5 pbw. The composition is vulcanized at 160°C.

In the light of the above disclosure the prior art of CAPORICCIO clearly anticipates claims rejected above.

7. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by OKI (US 5,208,293).

The prior art of OKI discloses fluorinated rubber composition based on fluorinated polyvinyl ethers. The crosslinking agent is peroxide and reinforcing filler is carbon black. Per 100 parts of the rubber polymer carbon black is utilized in 5 pbw and peroxide is utilized in 1 pbw.

The article is utilized to make sealing compositions for oil seals, glass run, kinetic joints, valves, and toner seals.

In the light of the above disclosure the prior art of OKI clearly anticipates claims rejected above.

Art Unit: 1714

8. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by GUERRA (US 5,226,650).

The prior art of GUERRA discloses composition utilized in automotive industry in fuel line hoses and o-rings. Filler such as carbon black is utilized in amount of 15-50 pbw, crosslinking agent, if used, the amount is 1-6 pbw.

In the light of the above disclosure the prior art of GUERRA anticipates claims rejected above.

9. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by SAITO (US 5,717,036).

SAITO discloses composition for use in automotive industry and in articles such as diaphragm and o-rings. The composition is based on fluorinated vinyl ether polymer. Curing agent is peroxide utilized in amount of 1.0-5.0 pbw. Carbon black is utilized in amount of 20 pbw.

In the light of the above disclosure, the prior art of SAITO anticipates claims rejected above.

10. Claims 1, 4-7 are rejected under 35 U.S.C. 102(b) as being anticipated by BARBIERI (US 6,005,054).

The prior art of BARBIERI discloses composition for making gaskets and other seals that can be utilized in airplanes, cars and other industries. The rubber is based on fluorinated

Art Unit: 1714

polyethers. Per 100 parts of rubber, peroxide curing agent is utilized in amount of 0.3-6 pbw and carbon black in a mount of 1-40 pbw. The composition is vulcanized with use of heat.

In the light of the above disclosure, the prior art of BARBIERI anticipates claims rejected above.

11. Claims 1, 4-7 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by TANAKA (US 6,703,461).

The prior art of TANAKA discloses composition for making articles having sealing properties such as sealants, o-rings, gaskets, diaphragms and other components for use in semiconductor manufacturing equipment.

The fluoro-rubber utilized in 100 pbw is cured with peroxide and comprises fillers such as carbon black or silica. Peroxide is utilized in amount of 0.5 pbw. The composition is cured with heat.

In the light of the above disclosure, the prior art of TANAKA anticipates requirements of claims rejected above.

12. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by OSAWA (US 6,576,701)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the

Art Unit: 1714

inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The disclosure of OSAWA clearly anticipates the present invention disclosing fluorinated polymer, reinforcing filler and peroxide.

In the light of the above disclosure, the prior art of OSAWA clearly anticipates claims rejected above.

13. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by MATSUDA (US 7,087,673)

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The disclosure of OSAWA clearly anticipates the present invention disclosing fluorinated polymer, reinforcing filler and peroxide.

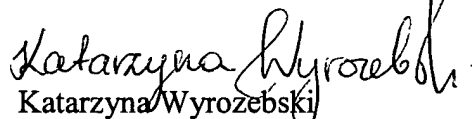
In the light of the above disclosure, the prior art of MATSUDA clearly anticipates claims rejected above.

Art Unit: 1714

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714